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10/783,001	02/20/2004	Christine Garcia	Serie 6114	7142

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EXAMINER	
COTTON, ABIGAIL MANDA	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/783,001	GARCIA, CHRISTINE	
	Examiner	Art Unit	
	Abigail M. Cotton	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *21 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-28 and 35* is/are pending in the application.

4a) Of the above claim(s) *13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-12,14-28 and 35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/21/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to the Amendment submitted by Applicants on November 21, 2005. Claims 10-28 and 35 are pending in the application, with claim 13 being withdrawn as drawn to non-elected invention. Accordingly, claims 10-12, 14-28 and 35 are being examined on the merits herein.

The objection to claim 11 is being withdrawn in view of Applicant's amendment to correct the typo-type error in this claim. The objection to claim 35 is also withdrawn in view of Applicant's amendment to re-number the claim.

Applicant's arguments filed November 21, 2005, with respect to the rejection of claims 9-21 under 35 U.S.C. 101 and 35 U.S.C. 112, second paragraph, for reciting a "use" of a composition have been fully considered and are persuasive. In particular, Applicant's cancellation of claim 9 and amendment of claims 10-12 and 14-21 to depend from claim 35 removes the grounds for the rejection of the claims under this section. Accordingly, the rejection of claims 10-21 under 35 U.S.C. 101 and 35 U.S.C. 112, second paragraph has been withdrawn.

Applicant's arguments filed November 21, 2005, have been fully considered but they are not persuasive. The following rejections having been necessitated by Applicant's amendments to the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-12, 14-23, 28 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2001/0002257 to Corrine Stolz, published May 31, 2001.

Stolz teaches a cosmetic composition of compounds of lipoamino acid structure and having germicidal activity (see paragraph 0001, in particular.)

Stolz exemplifies a cosmetic composition having 25% by weight of octanoylglycine with butylene glycol, glycerol and water (cosmetically acceptable medium), which is a composition that meets the limitations of claims 10, 12, 14-21 and 35 (see paragraphs 0077-0089, in particular.) Regarding claim 11, Stolz teaches that the active principle of the composition (such as octanoylglycine) can be present in the composition in the form of topically acceptable salts, and that the salt may be an alkali metal salt, among others (see paragraph 0015-0019, in particular.) Regarding claim 22,

Stolz teaches that the composition is cosmetic, and thus is administered topically. Regarding claim 23, Stolz's teaching of the composition having 25% by weight of octanoylglycine meets the limitation of being administered in the range of from "about" 0.01% to "about" 10% by weight. Regarding claim 28, Stolz teaches that the composition comprises Sepicide®HB, which is a self-emulsifiable composition based on fatty alcohols as emulsifier (see paragraph 0066, in particular.)

Claims 10-12, 14-23, 28 and 35 are directed to methods of utilizing a composition as a slimming agent, and for slimming the human body. Stolz teaches the claimed composition for topically applying to the skin. Such topical application will inherently act as a slimming agent as the same composition is being taught. Accordingly, the teachings of Stolz anticipate the inventions of claims 10-12, 14-23, 28 and 35.

It is noted that for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, the transitional phrase "consisting essentially of," for example as recited in claim 35, is being construed as equivalent to "comprising," absent a clear indication in the specification or claims of what is meant by, i.e. what is being excluded from the composition by, the phrase "consisting essentially of." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355, and MPEP 2111.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2001/0002257 to Stolz, published May 31, 2001.

Stolz is applied as discussed for claims 10-12, 14-23, 28 and 35 above. Stolz does not teach providing a specific composition having the percent ranges recited in claims 24-25. Stolz does not specifically teach the exemplified composition having the cosmetic forms recited in claim 26, and does not teach a specific composition that is dispersed or impregnated onto textile or nonwoven materials as in claim 27.

Regarding claim 26, Stolz teaches that the composition can be in the form of an aqueous solution and a simple emulsion, among others. Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the recited cosmetic form of claim 26, because Stolz teaches that such forms are suitable for the cosmetic composition.

Regarding claims 24-25, Stolz teaches that the active principle can comprise from 0.001% to 6% by weight of the composition (see paragraph 0071, in particular), which overlaps with the ranges recited in the claims. Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide a weight percentage within the claimed ranges, because Stolz teaches that weigh percentages within the claimed range are suitable for the cosmetic composition. Furthermore, one of ordinary skill in the art at the time the invention was made would have found it obvious to optimize the weigh percentage to provide a desired composition. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Regarding claim 27, Stolz teaches that suitable formulations for the cosmetic composition can be in the form of wipes (see paragraph 0064, in particular), which are either textile or nonwoven materials. Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to disperse or impregnate the composition onto textile or nonwoven materials, because Stolz teaches that a wipe having the composition is a suitable formulation.

Response to Arguments

Applicant's arguments filed November 21, 2005 have been fully considered but they are not persuasive.

In particular, Applicant's argue that Stolz et al. does not teach slimming by administering a composition consisting essentially of a cosmetically acceptable medium and an effective quantity of a compound represented by formula (I). The Examiner respectfully points out that for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, the transitional phrase "consisting essentially of," as recited for example in claim 35, is being construed as equivalent to "comprising," absent a clear indication in the specification or claims of what is meant by, i.e. what is being excluded from the composition by, the phrase "consisting essentially of." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355, and MPEP 2111.03. Stolz et al. teaches administering a composition comprising the cosmetically acceptable medium and effective quantity of the compound represented by formula (I), and thus meets the limitations of the claims.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMC

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER